

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

***Ex parte*** NORIO OGURA, KAZUHIKO FURUKAWA, and KATSUHIKO  
SHIRAISHI

---

Appeal No. 1999-1064  
Application No. 08/654,766

---

HEARD: January 27, 2000

---

Before ABRAMS, McQUADE, and BAHR, Administrative Patent Judges.  
ABRAMS, Administrative Patent Judge.

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner finally rejecting claims 8-23, which constitute all of the claims remaining of record in the application.

The appellants' invention is directed to an ink follower for a ballpoint pen. The claims on appeal have been reproduced in an appendix to the Appellants' Brief.

**THE APPLIED REFERENCES**

Urquhart 1967	3,334,616	Aug. 8,
Case et al. (Case) 1987	4,671,691	Jun. 9,
Shiraishi 20, 1994	5,348,989	Sep.
	(filed Mar. 24, 1993)	
British Patent Application 1958	798,897	Jul. 30,
Canadian Patent 1962	646,258	Aug. 7,
Japanese Publication 1974	49-30035	Mar. 19,

**THE REJECTION**

Claims 8-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over the British reference in view of the Canadian reference, Urquhart, the Japanese reference, Case and Shiraishi.

Rather than attempt to reiterate the examiner's full commentary with regard to the rejections and the conflicting viewpoints advanced by the examiner and the appellants

regarding the rejections, we make reference to the Examiner's Answer (Paper No. 24) and to the Appellants' Briefs (Papers No. 23 and 26).

### OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claims, the prior art applied against the claims, and the respective views of the examiner and the appellants as set forth in the Answers and the Briefs. As a result of our review, we have determined that the rejection should not be sustained. Our reasoning in support of this conclusion follows.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See ***Ex***

**parte Clapp**, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellants' disclosure. See, for example, **Uniroyal, Inc. v. Rudkin-Wiley Corp.**, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1438 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

The appellants' invention relates to an ink follower for an aqueous ball point pen whose function is to prevent the ink from leaking out when the pen is placed sideways or upside down and, particularly, when the pen is dropped and the ink receives an impact. According to the appellants, prior art ink followers failed in this regard. Four independent claims are before us, with claims 8 and 12 setting forth the invention in terms of an ink follower for an aqueous ballpoint pen, and claims 16 and 20 as an aqueous ballpoint pen having an ink reservoir. In each of the four independent claims the invention comprises a "gel-like material" and a "solid piece introduced into the gel-like material," but the claims differ

in the manner and detail to which each of these components is described. The examiner has combined the teachings of six references in order to arrive at the conclusion that each of the claims is unpatentable, and the appellants have argued in general that the examiner has provided no valid reasons why one of ordinary skill in the art would have been motivated to combine the teachings of the six references in the manner proposed by the examiner, and in particular that there would have been no suggestion to replace the solid piece disclosed in the British reference with that of the Japanese reference. We need look no further than that argument to determine that the rejection cannot be sustained.

One of the structural limitations recited in all four of the independent claims is that the solid piece introduced into the gel-like material has "an essentially uniform cross-sectional area along its entire longitudinal length." The British reference discloses an ink follower comprising a small quantity of viscous oil (7) at the top of the column of ink, and a solid piece (plug 5) partially submerged in the oil. As pictured in Figure 1, the solid piece has a cylindrical body bounded by upper and lower circumferential flanges (6), and in

the embodiment of Figure 2 a cylindrical body bounded at the top by a flange (6) and at the bottom by an inverted cone-shaped portion (8) that has no flange. According to the British invention, it is necessary to "ensure a fluid-tight seal of the plug in the bore" (emphasis added), which is accomplished the use of flanges at one or both ends, with the oil being retained in the narrowed waist portion (page 1, line 59 *et seq.*; page 2, lines 12-22 and 75-95). Thus, the British reference fails to disclose or teach a solid piece having an essentially uniform cross-sectional area along its entire longitudinal length, as is required by the four independent claims.

The examiner has taken the position that it would have been obvious to one of ordinary skill in the art to modify the British reference by providing solid piece 5 with an essentially uniform cross-sectional area along its length, in view of the teaching of the Japanese reference, suggestion being "[t]he motivation provided by the secondary references" (Answer, page 4). The examiner has not pointed out any portion of either reference as the basis for the "motivation" to make the proposed modification to the solid piece of the British

reference, stating only that the basis is the "conventionality" established by the Japanese publication and Urquhart (Answer, page 4). However, it is axiomatic that the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See, for example, ***In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The crux of the operation of the solid piece in the British reference is the containment of the oil around a waist portion by a closely fitting flange. Therefore, absent evidence to the contrary, from our perspective it would appear that the modification proposed by the examiner would cause the system disclosed in the British reference to become inoperative, which would have been a disincentive for one of ordinary skill in the art to make the proposed change. We further point out that the plug disclosed in the Japanese reference is not "a solid piece" (emphasis added), as required by the four independent claims and that it is cup-shaped; thus, while it has a uniform diameter along its entire length, it does not have an essentially uniform cross-sectional area. The same can be said for the Urquhart plug, which is hollow and is tapered at one

end. Therefore, even considering, *arguendo*, that suggestion were to exist for altering the solid piece disclosed in the British publication in accordance with the teachings of these two secondary references, the result would not be the claimed invention.

For the reasons set forth above, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify the British device in the manner proposed by the examiner. This being the case, it is our conclusion that a *prima facie* case of obviousness has not been established with regard to any of the four independent claims. We therefore will not sustain the rejection of independent claims 8, 12, 16 and 20 or, it follows, of claims 9-11, 13-15, 17-19 and 21-23, which depend therefrom.



**SUMMARY**

The rejection is not sustained.

The decision of the examiner is reversed.

**REVERSED**

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

NEA/jlb

Appeal No. 1999-1064  
Application No. 08/654,766

Page 10

DARBY & DARBY  
805 THIRD AVENUE  
NEW YORK, NY 10022